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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

NI, SUHAN

ART UNIT	PAPER NUMBER
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2614

MAIL DATE	DELIVERY MODE
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03/18/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/581,530	Applicant(s) TIPSMARK ET AL.	
	Examiner Suhan Ni	Art Unit 2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. This communication is responsive to the preliminary amendment filed 06/02/2006.
2. The Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit **2614**.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130 (b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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3. Claims 1-10 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of U.S. Patent No. 7,616,773. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-5 of U.S. Patent No. 7,616,773 are similar in scope to claim 1-10 of the U. S. Pat. App. No. 10/581,530 with only obvious wording variations. For example:

Claims 1-2 claims the similar structured device with receiver and casing parts which is a fiber-reinforced polymer with fiber content between 40% and 60% as the applicants claimed in claims 1-3 of U.S. Patent No. 7,616,773 (~773 hereafter). Furthermore, ~773 may not specially claim a microphone as claimed in the application. Since providing a microphone for a communication device, such as a hearing aid is very well known in the art, it therefore would have been obvious to one skilled in the art at the time the invention was made to be motivated to provide a suitable microphone for the hearing aid claimed in ~773, in order to manufacture the hearing aid.

Specification

4. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph **on a separate sheet** within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

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The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

The size of the fonts and spacing of the lines of the specification are such as to make reading and entry of amendments difficult. New application papers with lines double spaced on good quality paper are required.

Claim Rejections - 35 USC § 112, 1st Paragraph

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1-10 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The feature of "at least one of the casing parts are shaped from **an injection molded fiber-reinforced polymer which has fiber content between 30% and 75% by weight**" is not clearly supported by specification.

Claim Rejections - 35 USC § 112, 2nd Paragraph

The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

6. Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1, the limitation of “**fiber content between 30% and 75% by weight**” in lines 6-7 is indefinite since it is not clear how such limitation has been determined.

Regarding claim 2, the limitation of “**fiber content between 40% and 60% by weight**” in line 2 is indefinite since it is not clear how such limitation has been determined as well.

...

Regarding claim 5, the limitation of “**the reinforced polymer compound has a B-module which is higher than 13 MPa**” in lines 2-3 is indefinite since it is not clear how such limitation has been determined.

...

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Based on the best understanding of the claim language regarding the 112, 1st and 2nd paragraph rejection as mentioned above in paragraph 5 and 6 of this office action, Claims 1-10

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are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoneta et al. (U. S. Pat. - 5,663,276).

Regarding claim 1, Yoneta et al. disclose a device comprising casing parts, wherein at least one said casing parts is shaped from an injection molded fiber-reinforced polymer which has a fiber contents between 30% and 75% by weight (col. 8, lines 8-67) as claimed. But Yoneta et al. may not clearly teach all the details of the device as claimed. Since Yoneta et al. do suggest utilizing said casing parts in a hearing aid (col. 9, line 34), and providing suitable/necessary elements for a communication device, such as a hearing aid is very well known in the art, it therefore would have been obvious to one skilled in the art at the time the invention was made to be motivated to provide suitable casing parts taught by Yoneta et al. for a communication device, such as a hearing aid with all suitable/necessary/well-known elements, in order to utilize the casing parts in a hearing aid (which is also suggested by Yoneta et al (col. 9, line 34)).

Regarding claim 2, Yoneta et al. further disclose the device, wherein the fiber content is between 40% and 60% and preferably at 50% by weight (col. 8, lines 63-67).

Regarding claims 3-4, Yoneta et al. further disclose the device, wherein the reinforced polymer is a polymylamide-based compound and the fiber-reinforcement comprises glass fibers (col. 8, lines 8-22) as claimed.

Regarding claims 5-7, Yoneta et al. may not clearly teach that the reinforced polymer compound has an E-module which is higher than 13, 15 or 18 MPa as claimed. Since Yoneta et al. do not specially restrict the reinforced polymer compound, and providing suitable and commercially reinforced polymer compound for casing parts of a communication device, such as a hearing aid is very well known in the art, it therefore would have been obvious to one skilled in

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the art at the time the invention was made to be motivated to provide suitable reinforced polymer compound, for example with B-module which is higher than 16 MPa, for the casing parts taught by Yoneta et al. of a communication device, such as a hearing aid, in order to provide a comfort fit to user's ear canal (with proper softness/hardness).

Regarding claims 8-10, Yoneta et al. may not clearly teach all the details of the device as claimed. Since Yoneta et al. do suggest utilizing said casing parts in a hearing aid (col. 9, line 34), and providing suitable/necessary elements for a communication device, such as a hearing aid is very well known in the art, it therefore would have been obvious to one skilled in the art at the time the invention was made to be motivated to provide suitable casing parts taught by Yoneta et al. for a communication device, such as a hearing aid with all suitable/necessary/well-known elements, in order to utilize the casing parts in a hearing aid (which is also suggested by Yoneta et al (col. 9, line 34)).

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Suhan Ni** whose telephone number is **(571)-272-7505**, and the number for fax machine is **(571)-273-7505**. The examiner can normally be reached on Tuesday and Thursday from 10:00 am to 8:00 pm, and may be reached on Monday, Wednesday and Friday from 10:00 am to 8:00 pm. If it is necessary, the examiner's supervisor, **Curtis A. Kuntz**, can be reached at **(571)-272-7499**.

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10. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (**PAIR**) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov/>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

11. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the group receptionist whose telephone number is **(571)-272-2600**, or please see <http://www.uspto.gov/web/info/2600>.

/Suhan Ni/

Primary Examiner, Art Unit 2614